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William R. Matz

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EXAMINER

STRANGE, AARON N

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/039,062	<b>Applicant(s)</b> MATZ ET AL.	
	<b>Examiner</b> AARON STRANGE	<b>Art Unit</b> 2453	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 45-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20081205</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claim 66 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's remaining arguments with have been fully considered but they are not persuasive.
3. With regard to claim 45, and Applicant's assertion that Kramer fails to disclose "calculating a score for the content item by comparing the at least one associated tag to the user profile" and "comparing the score to a threshold score" (Remarks 7), the Examiner respectfully disagrees. Kramer discloses calculating a score (match score) for a content item by comparing associated tags (target vector) with a user profile (attribute vector) and comparing the score to a threshold score (col. 23, ll. 15-22; col. 23, l. 66 to col. 24, l. 4) to select relevant content.
4. With regard to claim 56, and Applicant's assertion that Kramer fails to disclose "receiving an internal insertion event for a content menu" and "ordering the content menu with content items having a highest probability of interest according to the user profile" (Remarks 7), the Examiner respectfully disagrees. Kramer discloses receiving an internal insertion event (event that causes the content rotator to be populated) for a content menu (content rotator) and ordering the content menu with items having a

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highest probability of interest according to the user profile (content is inserted into the menu in the order specified by the sorter)(col. 31, ll. 33-37).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 66 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. With regard to claim 66, the limitation "presenting a targeted content item when the targeted content item is associated with a zone improvement plan matching the user profile" is not described in the specification. It is noted that Applicant alleges support for this limitation may be found at page 33, lines 3-9 (Remarks 7). However, there is no page 33 in the specification of the present application.

It appears that Applicant may have intended to refer to page 22, lines 3-9, which describes targeting content to everyone within a particular zip code. However, page 22 of the specification fails to support presenting a targeted content item if the content is

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associated with a ZIP code matching the user profile, since page 22 of the specification states that everyone in the zip code would be targeted "regardless of the user profile" (p. 22, ll. 8-9).

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 66 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. With regard to claim 66, the limitation "a zone improvement plan matching the user profile" is unclear. It appears that Applicant may be referring to a Zone Improvement Plan (ZIP) code, and it has been interpreted as such for the purpose of applying prior art.

### ***Claim Rejections - 35 USC § 101***

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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12. Claims 45-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

13. Claim 45 is directed to a method of targeting content. None of the claimed steps are sufficient to tie the claimed method to a particular machine or apparatus, since none of the steps even recite a machine or apparatus. Additionally, none of the claims steps transform any article into a different state or thing. Therefore, the claim does not qualify as a patent-eligible process claim. *See In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008).

14. All claims not individually directed are rejected by virtue of their dependency from the above claims and their failure to remedy the above noted deficiency.

### ***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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16. Claims 45-65 are rejected under 35 U.S.C. 102(e) as being anticipated by Kramer et al. (US 6,327,574).

17. With regard to claim 45, Kramer discloses a method of targeting content, comprising:

receiving multiple data streams, each data stream comprising a content item (commercials and/or announcements) and at least one tag (selection criteria)(col. 9, ll. 48-51) (also a webpage embodiment at col. 7, l. 55 to col. 8, l. 40);

storing a user profile (col. 10, ll. 41-45) having at least one profile tag (characteristic value)(col. 10, ll. 51-61);

calculating a score for the content item by comparing the at least one associated tag to the user profile (match score is computed by the matching subsystem)(col. 23, l. 66 to col. 24, l. 4);

comparing the score to a threshold score (match score is compared to a threshold associated with each illumination)(col. 23, ll. 15-22);

when the score satisfies the threshold score, then determining that the content item is appropriate for presentation (if the match score exceeds the threshold, the content is selected and placed into the sorted illumination list)(col. 23, ll. 15-22); and

selecting one of the multiple data streams having the score that satisfies the threshold score (the “most appropriate” content is selected)(col. 8, ll. 34-37; col. 9, ll. 51-53).

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18. With regard to claim 46, Kramer further discloses defining the user profile based on usage (Col 3, lines 10-14).

19. With regard to claim 47, Kramer further discloses defining the user profile based on manual input (Col 10, lines 32-33 and Col 14, lines 36-42); (information manually entered on forms).

20. With regard to claim 48, Kramer further discloses detecting a pattern in user selections and updating the user profile with the pattern (user profile is continuously updated based on user selections)(col. 32, l. 32 to col. 33, l. 47).

21. With regard to claim 49, Kramer further discloses that evaluating the at least one tag comprises correlating the at least one tag to the at least one profile tag (tags from the product and consumer profiles are correlated to determine an appeal score)(col. 11, ll. 17-21).

22. With regard to claim 50, Kramer further discloses storing the selected one of the multiple data streams (data stream must be stored, at least temporarily, to be displayed, particularly with respect to web page content)(col. 8, ll. 41-63; col. 9, ll. 51-53).

23. With regard to claim 51, Kramer further discloses filtering out unselected data streams (unselected streams are not displayed)(col. 9, ll. 51-53).

24. With regard to claim 52, Kramer further discloses receiving a tag identifier associated with the at least one tag (an identifier associated with the tag is inherently received, so that the recipient can properly identify which tag contains which value).

25. With regard to claim 53, Kramer further discloses that receiving the multiple data streams comprises receiving a classification associated with the at least one tag (information about merchants and products includes classification information)(col. 10, ll. 33-34).

26. With regard to claim 54, Kramer further discloses detecting an insertion event (content is dynamically inserted based on user requests and profile information)(col. 6, ll. 22-24; col. 8, ll. 24-31; col. 9, ll. 45-53).

27. With regard to claim 55, Kramer further discloses causing presentation of the selected one of the multiple data streams (selected content is displayed)(col. 8, ll. 34-37; col. 9, ll. 51-53).

28. With regard to claim 56, Kramer discloses a system for targeting content, comprising:

a processor communicating with memory (col. 20, ll. 57-61);

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the processor receiving an internal insertion event for a content menu (content may be inserted into a content rotator)(col. 30, ll. 60-67);

the processor receiving multiple data streams, each data stream comprising a content item (commercials and/or announcements) and at least one associated tag (selection criteria)(col. 9, ll. 48-51) (also a webpage embodiment at col. 7, l. 55 to col. 8, l. 40);

the processor storing a user profile in the memory (col. 10, ll. 41-45) having at least one profile tag (characteristic value)(col. 10, ll. 51-61);

the processor calculating a score for the content item by comparing the at least one associated tag to the user profile (match score is computed by the matching subsystem)(col. 23, l. 66 to col. 24, l. 4) and the processor comparing the score to a threshold score (match score is compared to a threshold associated with each illumination)(col. 23, ll. 15-22);

when the score satisfies the threshold score, then the processor determines that the content item is appropriate for presentation (if the match score exceeds the threshold, the content is selected and placed into the sorted illumination list)(col. 23, ll. 15-22); and

the processor selecting one of the multiple data streams having the score that satisfies the threshold score (the “most appropriate” content is selected)(col. 8, ll. 34-37; col. 9, ll. 51-53); and

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the processor ordering the content menu with content items having a highest probability of interest according to the user profile (content is inserted into the menu in the order specified by the sorter)(col. 31, ll. 33-37).

29. Claims 57-65 are rejected under the same rationale as claims 46-55, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

***Claim Rejections - 35 USC § 103***

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer et al. (US 6,327,574) in view of Frengut (US 2002/0046099).

32. With regard to claim 66, while the system disclosed by Kramer shows substantial features of the claimed invention (discussed above with respect to claim 56), it fails to disclose presenting a targeted content item when the targeted content item is associated with a zone improvement plan matching the user profile.

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Frengut discloses a similar system for providing customized content to users (Abstract). Frengut teaches presenting targeted content to users based on the content item being associated with a ZIP code of the user (user's custom web page is generated based in part on the user's zip code)(¶32). This would have been an advantageous addition to the system disclosed by Kramer since it would have allowed information to be provided to users based on their zip code, allowing advertisers to target content to particular locations.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to present targeted content to users based on a zip code matching the user's profile, to allow advertisers to target content to particular geographical locations.

### ***Conclusion***

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/  
Examiner, Art Unit 2453